

Remarks

The present amendment is made in response to the Office Action dated January 12, 2006, and identified as Paper No. 12192005. Claims 13-20 are pending in the present application.

In the Action, the Examiner rejected claims 1-12 under 35 U.S.C. § 112, second paragraph as indefinite. Claims 1-8 and 10-12 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Publication No. 2002/0065682 to Goldenberg ("*Goldenberg*") in view of U.S. Patent No. 6,505,166 to Stephanou ("*Stephanou*"). Claim 9 was rejected under 35 U.S.C. § 103(a) as obvious over *Goldenberg* and *Stephanou* in further view of U.S. Patent No. 6,368,273 to Brown ("*Brown*").

I. Rejections under 35 U.S.C. § 112, second paragraph

Applicant has rewritten claim 1 as claim 13 in an attempt to more clearly recite method of the present invention. Applicant has not introduced any new matter into the claims, and has instead tried to more clearly represent the elements of the previously recited claims.

II. Rejections under 35 U.S.C. § 103(a) in view of *Goldenberg* and *Stephanou*

According to the Examiner, *Goldenberg* discloses all of the elements of the claimed invention, except for the step of interfacing with the clients own systems, which is purportedly supplied by *Stephanou*. *Goldenberg* does not in fact disclose all of the elements that are attributed to the reference by the Examiner. As a result, the proposed combination of *Goldenberg* and *Stephanou* fail to disclose each and every element of the invention now recited in the claim, as required for a *prima facie* rejection under 35 U.S.C. § 103. See MPEP § 2143.03 ("To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art").

More particularly, *Goldenberg* discloses a system for enabling *patients* to remotely connect with physicians to obtain updated information about diagnoses and condition. In other words, the system disclosed in *Goldenberg* provides a “virtual doctor” to help in diagnosis and treatment. While this ability is certainly beneficial, it has nothing to do with the present invention.

The present invention is a system and method that allows health care payors, such as insurance companies and self-insured employers (specifically defined as “clients” on page 7, line 4 and on page 14, lines 13-16 of the specification of the present invention), to locate and facilitate referrals to specialists that may be needed by a patient whose medical costs are borne by the client. Generally, such referrals are only possible to “in-network” physicians that have contracts with the payors. The method of the present invention allows clients to establish and track referrals to physician specialists that may be “out-of-network” by using previously arranged referral service provided by the present invention. The method of the present invention further allows for the automated transfer of confidential medical records from the client to the out-of-network physician to assist with the referral. More particularly, claim 13 recites the steps of:

- providing secure access to the network to a client through a computer terminal;
- allowing said client to request a referral for a specific medical need;
- retrieving from a referral database information about at least one physician capable of handling the referral;
- displaying said information for said client;
- allowing said client to select said at least one physician;

requesting a response from said client to at least one inquiry established by said at least one physician;

securely transmitting patient information from a client database to said at least one physician after receiving a response to said inquiry;

generating a referral to have said at least one physician provide medical services;

tracking said referral to ensure that the medical services are provided.

Rather than selecting an expert in response to an inquiry from a *client* (such as an insurance company or self-insured employer) as specifically recited in claim 13, *Goldenberg* allows a *patient* to locate and view the resume of a potential specialist. *See Goldenberg*, Paragraph [0050]. *Goldenberg* thus fails to disclose all of the elements which require interaction between the client and the network, and between the client and the physician, as affirmatively recited in claims 13-20.

Goldenberg also fails to disclose having the selected expert provide at least one inquiry to the client, as affirmatively recited in claim 13. Indeed, the only interaction provided by the system of *Goldenberg* is to allow the specialist to decline an assignment. *See Goldenberg*, Paragraph [0050].

Thus, the combination of *Goldenberg* and *Stephanou* fails to disclose several elements of the claimed invention, as otherwise required for a proper obviousness rejection.

In any event, the Examiner failed to provide a proper motivation or suggestion to combine *Goldenberg* and *Stephanou*, as required for a *prima facie* case of obviousness under 35 U.S.C. § 103. *See* MPEP § 2143.01. In order to support the proposed combination of *Goldenberg* and *Stephanou*, the Examiner is required to point to evidence in the prior art why one of ordinary skill would be motivated to combine the references to form the claimed

invention. The Examiner simply referred to a general statement in the summary of *Stephanou* about the usefulness of the invention for a virtual help desk. The statement relied on by the Examiner does not provide any basis why one of ordinary skill in the art would modify the system of *Goldenberg* to include an interface for capturing preexisting information to reduce errors. In fact, the "motivation" identified by the Examiner has nothing to do with capturing preexisting information. Accordingly, the Examiner failed to state a *prima facie* case of obviousness.

II. Rejections under 35 U.S.C. § 103(a) in view of *Goldenberg*, *Stephanou* and *Brown*

As explained above, the combination of *Goldenberg* and *Stephanou* does not disclose each and element of the claimed invention and lacks a proper motivation or suggestion. Accordingly, the addition of *Brown* to the proposed combination still fails to disclose each and every element of the claimed invention, as required for a proper rejection under 35 U.S.C. § 103.

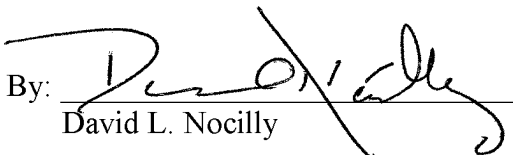
Applicant grants authorization to charge any fees in regard to this response to Deposit Account No. 50-1546.

In view of the foregoing, the Examiner's reconsideration and allowance of the claims of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant's attorney would expedite prosecution of this application, please contact the undersigned at (315) 218-8515.

Respectfully submitted,

Philip J. Passantino

Date: April 12, 2006

By: 
David L. Nocilly

Response to Office Action dated January 12, 2006
Application Serial No. 10/035,970
Amendment dated: April 12, 2006

Applicant's Attorney
Registration Number 48,259

BOND, SCHOENECK & KING, PLLC
One Lincoln Center
Syracuse, New York 13202-8530
(315)218-8515